

REMARKS / ARGUMENTS

Status of Claims

Claims 1-15, all of the claims pending in the application, are rejected. No claim is allowed. Claim 8 is amended. Of the pending claims, Applicant herein provides clarifying remarks to traverse the rejections.

Applicant respectfully submits that the rejections under 35 U.S.C. §112, second paragraph, and 35 U.S.C. §102(b), have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 10-15 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention.

The Examiner comments that uncertainty exists as to how Claims 10-15 can refer to the "first axis" as claimed, and requests correction and/or clarification. Applicant traverses this comment for the following reasons.

Applicant respectfully submits that where the specification provides general guidelines as to the scope of the invention such that one of ordinary skill in the art would know what was meant, the subject matter of the invention would have been described and supported in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicant believes the present specification and claims satisfy that burden.

Paragraphs [0012]-[0013] and Figures 1-4 disclose an apparatus comprising an examination arm (12) mounted on a C-shaped arm (8) and having an axis of rotation (*first axis*) (20) (Paragraph [0013]). The C-shaped arm (8) is in a vertical plane whereby its axis of rotation (*second axis*) (22) is horizontal (Paragraph [0012]).

Paragraph [0014] and Figure 1 disclose the first axis (20) of the examination arm (12) being substantially horizontal and the examination arm (12) being substantially vertical, such that the plane in which examination arm (12) will move during rotation about first axis (20) is a vertical plane (Paragraph [0014]). Accordingly, Applicant has

clearly and precisely described that "...the angular rotation of the examination arm about the first axis defines a vertical plane", as recited in claims 10-11.

Paragraph [0017] and Figure 3 disclose the first axis (20) being oriented about 30 degrees with respect to the horizontal and the examination arm (12) being oriented about 30 degrees with respect to the vertical, such that the plane in which examination arm (12) will move during rotation about first axis (20) is an inclined plane (Paragraph [0017]). Accordingly, Applicant has clearly and precisely described that "...the angular rotation of the examination arm about the first axis defines an inclined plane", as recited in claims 12-13.

Paragraphs [0019] and [0022], and Figure 4, disclose the first axis (20) of the examination arm (12) being substantially vertical and the examination arm (12) being substantially horizontal, such that the plane in which examination arm (12) will move during rotation about first axis (20) is a horizontal plane (Paragraph [0022]). Accordingly, Applicant has clearly and precisely described that "...the angular rotation of the examination arm about the first axis defines a horizontal plane", as recited in claims 14-15.

In view of the foregoing, Applicant respectfully submits that the subject matter as claimed is described in such a manner that reasonably conveys to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection, which Applicant considers to be traversed.

Rejections Under 35 U.S.C. §102(b)

Claims 1-15 are rejected under 35 U.S.C. §102(b) as being anticipated by Coe (U.S. Patent No. 5,305,365) (hereinafter, Coe). The Examiner comments that Coe teaches the invention as claimed including "...the arm being mounted for rotation about a first axis (i.e. common axis of outer tube 90 and inner tube 110; col. 4, lines 35-39) substantially perpendicular to the direction of the examination arm *and passing through the center of an examination position...*" (emphasis added) (Paper 6, page 3). Applicant traverses this comment for the following reasons.

Coe discloses a mammography system with a variable angle, rearwardly tilting mammograph adjustable to individual, standing or sitting patients in forwardly leaning posture to maximize breast tissue exposure to the mammograph by gravity (Abstract). Included in Coe's mammography system is an examination arm (12) mounted for rotation about a first axis (common axis of outer tube 90 and inner tube 110; col. 4, lines 35-39). However, notably absent from Coe is any disclosure of the first axis passing through the center of an examination position.

Applicant respectfully submits that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, *in a single prior art reference.*" *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the *** claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In comparing Coe with the instant invention, Applicant respectfully submits that claims 1 and 8 include the element of "...the arm being mounted for rotation about a first axis substantially perpendicular to the direction of the examination arm *and passing through the center of an examination position.*" (emphasis added). Applicant finds no disclosure of this element in Coe, and the Examiner has not explained how Coe does disclose this element.

Dependent claims inherit all of the limitations of the respective parent claim.

Paragraph [0013] and Figures 1-4 disclose the axis of rotation (first axis) (20) of the examination arm (12) passing through the center of the examination position intended for an object, such as a patient's breast, which obviates the need to modify the position of the support on the support column when changing over from taking a cranio-caudal image to side views or other views (Paragraph [0013]). In comparison, Coe discloses in Figure 1 a first axis (common axis as discussed previously) that does not pass through the center of the examination position intended for the patient's breast, and therefore cannot provide the advantage provided for in the invention as disclosed and claimed.

In view of the foregoing remarks, Applicant submits that Coe does not disclose each and every element of the claimed invention and therefore cannot be anticipatory.

Accordingly, Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §102(b) has been traversed, and requests that the Examiner reconsider and withdraw all of the rejections under 35 U.S.C. §102(b).

In light of the forgoing, Applicant respectfully submits that the Examiner's rejections under 35 U.S.C. §112, second paragraph, and 35 U.S.C. §102(b), have been traversed, and respectfully requests that the Examiner reconsider and withdraw all of these rejections and requests that a timely Notice of Allowance be issued in this application.

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 09-0470.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above identified Deposit Account.

Respectfully submitted,

ALAIN MARIE

By: 

Jay L. Chaskin
Reg. No. 24030

Address: General Electric Company
3135 Easton Turnpike
Fairfield CT 06828

Fax: 203-373-3991
Tel: 203-373-2867
Email: jay.chaskin@corporate.ge.com